

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant : David M. Berezowski et al.
Application No. : 09/823,705 Confirmation No.: 7437
Filed : March 30, 2001
For : SYSTEMS AND METHODS FOR IMPROVED
AUDIENCE MEASURING
Art Unit : 2424
Examiner : Annan Q. Shang

New York, New York 10036
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REPLY BRIEF

Sir:

Pursuant to 37 C.F.R. § 41.41(a), appellants are filing this Reply Brief in reply to the Examiner's Answer dated November 17, 2008 (hereinafter "the Examiner's Answer"), and in support of their appeal from the final rejection of claims 1-6, 8-11, 13-46, 50-56, 58, 60-85, 87-90, 92-125, 129-135, 137, 139-164, 166-169, 171-204, 208-214, 216, and 218-237 in the Office Action dated March 22, 2007. Appellants previously filed a Notice of Appeal on September 20, 2007 along with a Pre-appeal Brief Request for Review. Appellants then received a Notice of Panel Decision from Pre-Appeal Brief Review dated February 8, 2008 stating that appellant is required to submit an appeal brief in accordance with 37 C.F.R. § 41.37. Appellants then filed an Appeal Brief on August 8, 2008 (hereinafter "the Appeal Brief").

I. Introduction

Appellants maintain the position that claims 1-6, 8-11, 13-46, 50-56, 58, 60-85, 87-90, 92-125, 129-135, 137, 139-164, 166-169, 171-204, 208-214, 216, and 218-237 of the present application are patentable in view of Maissel et al .U.S. Patent No. 6,637,029 ("Maissel").

Appellants submit that the Examiner's Answer is insufficient as a matter of law to uphold the prior art rejections for at least the reasons set forth in appellants' Appeal Brief. Appellants have filed this Reply Brief to address comments in the November 17, 2008 Examiner's Answer and to further demonstrate the patentability of pending claims 1-6, 8-11, 13-46, 50-56, 58, 60-85, 87-90, 92-125, 129-135, 137, 139-164, 166-169, 171-204, 208-214, 216, and 218-237. Appellants submit that the Board should find the rejections of these claims to be in error and should reverse the Examiner.

II. Summary of the Examiner's Answer

The Examiner's Answer maintains the § 102(c) rejection of claims 1-6, 8-11, 13-46, 50-56, 58, 60-85, 87-90, 92-125, 129-135, 137, 139-164, 166-169, 171-204, 208-214, 216, and 218-237 from the March 22, 2007 Office Action and restates the same grounds of rejection from that Office Action.

The Examiner's Answer also provides a "Response to Arguments" section that addresses appellants' arguments presented in the Appeal Brief.

III. Argument of Independent Claims 1, 80, and 159

Appellants submit that the Examiner's Answer is insufficient to uphold the 35 U.S.C. § 102(e) rejections of claims 1-6, 11, 13-28, 80-85, 89, 92-107, 159-164, 169, and 171-186 for at least the reason that the Examiner has still failed to demonstrate that Maissel discloses the claimed features of "receiving indications of playbacks of [a] recorded program from a plurality of audience members" and "updating audience size information for the recorded program in response to receiving the indications" (independent claims 1, 80, and 159).

On page 15 of the Examiner's Answer, the Examiner alleges that appellants discuss parts of the disclosure "which are not in the claim limitations." Appellants respectfully submit that this allegation is baseless. Appellants' have repeatedly argued that, at bottom, "Maissel does not explicitly or implicitly show updating audience size information for a recorded program in response to receiving indications of playbacks of the recorded program from audience members." See the first sentence of section (vii)(A)(2) of the Appeal Brief. This argument is directly related to the language of appellants' claims. Further, while appellants have paraphrased portions of the claim language in the Appeal brief for clarity, these paraphrases are still within the limitations of appellants' claims. Accordingly, the Examiner's allegation that appellants discuss parts of the disclosure "which are not in the claim limitations" does not have any merit.

In order to anticipate a claim, each and every element of the claim must be either expressly or inherently described in a prior art reference. To rely upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily

flows from the teachings of the applied prior art. However, Maissel does not provide any such basis to show "receiving indications of playbacks of [a] recorded program from a plurality of audience members" or "updating audience size information for the recorded program in response to receiving the indications." On pages 16 and 17 of the Examiner's Answer, the Examiner cites various passages of Maissel that refer to customizing an electronic program guide and generating on-screen alerts by monitoring viewer behavior. The Examiner's argument appears to be that 1) Maissel's monitoring of "[p]ay program, non-pay or free programs, popular programs (col. 12, line 67), movies and NVOD (col. 19, lines 1-15), etc." is the same as appellants' claimed feature of receiving indications of playbacks of a recorded program, and that 2) Maissel's "provid[ing] audience information to user(s) with respect to programs currently being watch [sic] or not watched" is the same as appellant's claimed feature of updating audience size information for a recorded program in response to receiving indications of playback of the recorded program.

Appellants respectfully submit that contrary to first part of the Examiner's argument, Maissel does not show receiving indications of playback of a recorded program. Appellants have continually argued this point, but the Examiner has ignored it and simply requoted the same passages of Maissel. "Recorded" programs are programs that have been stored and played back after their broadcast. See appellants' specification, page 2, lines 13-21. Maissel does not mention recorded programs, let alone receiving indications of playback of recorded programs. Maissel only refers to monitoring the different types of broadcast programs, including pay-per-view (PPV) and near-video-on-demand (NVOD) programs. The Examiner has maintained, without any basis, that monitoring these different types of broadcast programs is the same as receiving indications of playback of a recorded program. PPV and NVOD programs are merely

programs that may be broadcast multiple times, at regular intervals, and are not the same as recorded programs. Accordingly, Maissel does not show receiving indications of playback of a recorded program. Moreover, the Examiner has failed to show that monitoring different types of broadcasts necessarily shows receiving indications of playback of a recorded program.

Appellants also respectfully submit that contrary to the second part of the Examiner's argument, Maissel does not expressly or inherently show updating audience size information for a recorded program in response to receiving indications of playback of the recorded program. Again, as discussed above, Maissel only refers to monitoring various types of broadcast programs and does not show receiving indications of playback of recorded programs. Thus, Maissel's audience information relating to programs "currently being watched or not watched" can only refer to broadcast programs, not recorded programs.

Further, Maissel does not show updating audience size information in response to receiving indications of playback. Maissel only refers to calculating "real-time information on a proportion or percentage of the audience viewing a particular program." See Maissel, 19:21-23. The Examiner has maintained, without any basis, that this calculation of "real-time information" is equivalent to updating audience size information in response to receiving indications of playback. However, the Examiner's claim is false. Maissel's "particular program[s]" only refer to broadcast programs. Nowhere does Maissel show that these particular programs are recorded programs. Thus, Maissel's "real-time information" is based on users watching broadcast programs, not receiving indications of playback as required by appellants' claims. Accordingly, Maissel does not explicitly show updating audience size information for a recorded

program in response to receiving indications of playback of the recorded program. Moreover, the Examiner has failed to show that Maissel's calculation of "real-time information" necessarily shows updating audience size information in response to receiving indications of playback.

For at least these reasons, as well as the ones stated in the Appeal brief, the Examiner has not met his burden of establishing a prima facie basis to deny patentability of appellants' claims 1, 80, and 159. Appellants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(e) is improper, and reversal is respectfully requested.

IV. Argument of Independent Claims 29, 108, and 187

Appellants submit that the Examiner's Answer is insufficient to uphold the 35 U.S.C. § 102(e) rejections of claims 29-46, 50, 108-125, 129, 187-204, and 208 for at least the reason that the Examiner has still failed to demonstrate that Maissel discloses the claimed feature of calculating audience size information "based on a graded approach of assigning a predetermined quantity of points to each of a plurality of actions performed by a plurality of audience members" (independent claims 29, 108, and 187).

On pages 17 and 18 of the Examiner's Answer, the Examiner continues to insist that Maissel's gathering of viewer behavior information is equivalent to the above-mentioned feature. Specifically, the Examiner points out that Maissel's monitoring agent collects viewing behavior data that:

"includes various viewer actions, such as, length of portions of viewed programs, preference strength (how strongly a certain program or type of program is preferred), percentage of all occurrences of the programs that were viewed, channel surfing behavior (actions of the viewers), where the viewer behavior data is determined based on these actions, compared to a predetermined threshold and further uses rule-base [sic] abstracted method

to generate various on-screen alerts to display behavior data or audience data of current programs being watched and programs not being watched..."

The Examiner then claims these portions of Maissel meet the above-mentioned claim limitation.

Appellants respectfully submit that the Examiner's position is erroneous, because all of these features of Maissel relate to the creation of viewer preference profiles rather than the calculation of audience size information as specified by appellants' claims. Maissel's preference profiles are only used to generate reminders and deliver customized program schedule information to the user. See Maissel, 13:9 through 14:20 and 18:58-67. Thus, the Examiner's contention that these features are related to calculating audience size information is false.

In particular, for example, Maissel's monitoring of the length of the portion of a television program viewed is not related to the calculation of audience size information. Instead, this information "determines the viewer preference profile information based, at least in part, on whether the length is greater than the threshold length." See Maissel 4:36-38. Thus, Maissel does not calculate audience size information based on this information. As another example, Maissel's monitoring of "the percentage of all occurrences of the program that were viewed" (*See* Maissel, 12:34-45) is not related to the calculation of audience size information. Instead, this collection of information is used to determine preference strength. See Maissel, 12:38-41. Nowhere does Maissel show that it calculates audience size information based on this ratio, or the amount of times a user has viewed a program. Accordingly, Maissel does not calculate audience size information based on this information. As yet another example, Maissel's determination of "channel surfing behavior" is not related to the calculation of audience

size information. Instead, Maissel's profile determination apparatus uses this information to determine viewer preference profile information. *See* Maissel, 4:45-51. Thus, Maissel does not calculate audience size information based on this information.

For at least these reasons, the Examiner has not shown that Maissel calculates audience size information "based on a graded approach of assigning a predetermined quantity of points to each of a plurality of actions performed by a plurality of audience members" as required by appellants' claims 29, 108, and 187, and the Examiner's rejection should be overturned.

Further, appellants contend that Maissel does not explicitly or implicitly show the feature of "assigning a predetermined quantity of points to each of a plurality of actions." There is simply no disclosure in Maissel that shows this feature. A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. For at least this additional reason, Maissel does not show each and every element of appellants' claims 29, 108, and 187, and the Examiner's rejection should be overturned. Appellants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(e) is improper, and reversal is respectfully requested.

V. Argument of Independent Claims 51, 130, and 209

Appellants submit that the Examiner's Answer is insufficient to uphold the 35 U.S.C. § 102(e) rejections of claims 51-56, 58, 60-70, 72-79, 130-135, 137, 139-149, 151-158, 209-214, 216, 218-228, and 230-237 for at least the reason that the Examiner has still failed to demonstrate that Maissel discloses the claimed feature of "receiving indications from a plurality of audience members to perform actions related to [an]

upcoming program" and "updating audience size information for [an] upcoming program in response to receiving the indications" (independent claims 51, 130, and 209).

On page 19 of the Examiner's Answer, the Examiner does not address the arguments made by appellant in section (vii.)C(1) and (vii.)C(2) of appellants' brief. Instead, the Examiner protests that appellants' use of the phrase "based on users viewing upcoming programs" in the arguments of this section of the Appeal Brief. Appellants respectfully submit that the Examiner's argument is baseless, as this phrase is within the above-mentioned limitation of appellants' claims. Further, appellants maintain that the substance of appellants' arguments in this section of the Appeal Brief holds true regardless – the Examiner's rejection did not previously address appellants' claimed feature of "receiving indications from a plurality of audience members to perform actions related to [an] upcoming program" and "updating audience size information for [an] upcoming program in response to receiving the indications."

Instead of addressing appellants' arguments, the Examiner merely cites to the same portions of Maissel as in previous sections of the Examiner's Answer. The Examiner's argument appears to be that because Maissel provides audience viewing information on a proportion of the audience viewing a "program not currently being viewed by a viewer," that Maissel "receiv[es] indications from a plurality of audience members to perform actions related to [an] upcoming program". *See* Maissel, 5:65-67. However, the Examiner's claim is without any factual basis. Maissel only refers to providing audience information about various types of broadcast programs, including pay-per-view (PPV) and near-video-on-demand (NVOD) programs. These programs are those that are currently broadcast, and are not upcoming programs – i.e. programs that will be broadcast in the future. Thus, when Maissel provides audience viewing

information on a "program not currently being viewed by a viewer," it is merely providing audience information for a currently broadcast program that the user is not watching. For at least this reason, Maissel does not show "receiving indications from a plurality of audience members to perform actions related to [an] upcoming program" as required by appellants' claims. Moreover, the Examiner has failed to show that providing audience information on the audience viewing a "program not currently being viewed by a viewer" necessarily shows that Maissel "receiv[es] indications from a plurality of audience members to perform actions related to [an] upcoming program."

In addition, Maissel makes no reference to updating audience size information for an upcoming program. Instead, provides audience information only based on programs currently being broadcast. This fact is evidence from Maissel's definition of audience, which is "the sum total audience viewing all programs at a particular time, or... the total audience of viewers who are capable of receiving programs at a particular time". *See* Maissel, 19:20-27. The audience "viewing all programs at a particular time" or the audience who is "capable of receiving programs at a particular time" clearly covers only those programs that are currently being broadcast at a specific time, which are not upcoming programs – i.e. programs that will be broadcast in the future. Therefore, Maissel does not show "updating audience size information for [an] upcoming program in response to receiving the indications" as required by appellants' claims.

For at least these reasons, Maissel does not show each and every element of appellants' claims 51, 130, and 209, and the Examiner's rejection should be overturned. Appellants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(e) is improper, and reversal is respectfully requested.

VI. Argument of Dependent Claims 9, 88, and 167

Appellants submit that the Examiner's Answer is insufficient to uphold the 35 U.S.C. § 102(e) rejections of claims 9, 88, and 167 for at least the reason that the Examiner has still failed to demonstrate that Maissel discloses the claimed feature of "updating audience size information based on the number of times each audience member played back the recorded program."

On pages 19 and 20 of the Examiner's Answer, the Examiner argues that Maissel shows the above-mentioned claim limitation because "Maissel monitors the user(s) viewing habits including the number of times the user plays back a recorded program and bills the user(s) accordingly." Appellants' respectfully disagree. As an initial matter, the Examiner's argument does not make sense – Maissel does not mention anything about billing a user based on the number of times a program is played back, and even if Maissel did, billing a user does not include calculating audience size information. Further, as argued in section III, Maissel's monitoring agent does not update audience size information for recorded programs. For at least this reason, Maissel does not show the features of claims 9, 88, and 167. Appellants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(e) is improper, and reversal is respectfully requested.

VII. Conclusion

For at least the reasons set forth above, appellants respectfully submit that claims 1-6, 8-11, 13-46, 50-56, 58, 60-85, 87-90, 92-125, 129-135, 137, 139-164, 166-169, 171-204, 208-214, 216, and 218-237 are in condition for allowance. The Examiner's rejections of these claims should be reversed.

Respectfully submitted,

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